SUPREME COURT, U.S.
Office-Supreme Court, U.S.
FILED
MAY 11 1967
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 1324

DOMENICO MASTINI,

Petitioner,

v.

AMERICAN TELEPHONE AND TELEGRAPH COMPANY and WESTERN ELECTRIC COMPANY,

Respondents.

DOMENICO MASTINI,

Petitioner,

v.

NEW YORK TELEPHONE COMPANY,

Respondent.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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May 10, 1967

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There is nothing about these ordinary patent cases which warrants review by this Court.

The decision of the Court of Appeals for the Second Circuit, holding petitioner's patent not infringed, is manifestly right. There is no conflict between decisions of Courts of Appeals. The patent in suit expired in 1955—nearly twelve years ago—and no question of public importance is involved. There has been no departure from the accepted and usual course of judicial proceedings. In sum, there is no special or important reason for granting a writ of certiorari in these cases.

Opinions Below

The Opinion of the Court of Appeals for the Second Circuit, dealing with the merits of the cases as well as petitioner's attack on the judgments, is reported at 369 F. 2d 378. It is reproduced as an appendix to this brief.

The Opinion of the District Court for the Southern District of New York, holding non-infringement, is reported at 236 F. Supp. 310. The District Court's memorandum Opinion of May 16, 1966, denying petitioner's Rule 60(b) motions attacking the judgments, is unreported. These Opinions appear in petitioner's appendix at P. App. 1-14a and P. App. 137* respectively.

Jurisdiction

The jurisdictional requisites are set forth in the petition.

Questions Presented

Petitioner's ten "Questions Presented" raise no issue which is appropriate for review by this Court. They represent nothing more than an attempt to relitigate issues twice decided adversely to petitioner in the courts below.

Questions 1-7 present the same arguments regarding the file wrapper estoppel and the judgments of non-infringement which were considered and rejected by the courts below. Questions 8 and 9 are obviously without merit, as is Question 10. The two independent actions in the Federal Courts in Delaware and Maryland, referred to in Question 10 as depriving the courts below of jurisdiction to act on petitioner's Rule 60(b) motions, raised the same issues as the Rule 60(b) motions in the courts below. Both were stayed pending the final result in these cases.

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*In this brief, citations to "P. App." refer to the appendices to petitioner's briefs in the Court of Appeals; citations to pages followed by "a" refer to the appendix to respondents' brief in the Court of Appeals.

The only real question presented here is whether or not petitioner is entitled to another hearing on the merits with respect to the alleged infringement of his patent. Clearly he is not, *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923).

Statement of the Case

As the case is inadequately stated in the petition, the following statement is made.

These consolidated actions are for alleged infringement of petitioner Mastini's patent No. 2,129,332, issued September 6, 1938 for a TELEPHONE SYSTEM (167a-170a). The patent relates to a specific type of radio-telephone system. The actions were brought in the summer of 1961, nearly six years after the September 6, 1955 expiration of the patent.

In December 1963 the parties entered into a stipulation describing the construction of respondents' accused radio-telephone systems. Thereafter respondents, on the basis of this stipulation (26a-44a) and the file wrapper (79a-164a) of the patent in suit, moved for summary judgments that none of their accused radio-telephone systems infringed the Mastini patent (69a-70a).

The District Court granted respondents' motions for summary judgment (P. App. 1-14a), and the Court of Appeals affirmed.

While petitioner's appeals from the grant of the motions for summary judgment of non-infringement were pending petitioner brought motions in the District Court, pursuant to Rule 60(b) of the Federal Rules of Civil Procedure, attacking the summary judgments on various grounds (P. App. 138-141). These motions were denied (P. App. 137), and again the Court of Appeals affirmed.

The radio-telephone systems involved in these cases consist essentially of a radio transmitter and receiver physically connected into a telephone wire line network—called the

local radio transmitter and receiver—which can communicate with another radio transmitter and receiver mounted, for example, in a car or boat—called the *remote* radio transmitter and receiver. The local radio transmitter and receiver provides the communication link between the telephone wire line network, to which it is connected, and the remote radio transmitter and receiver. Thus a person at a remote radio-telephone station is able, through the local radio transmitter and receiver, to converse with anyone connected into the ordinary telephone wire line network by an ordinary telephone in his home or office.

The patented and accused radio-telephone systems differ fundamentally in the location and operation of their local radio transmitters and receivers.

In the radio-telephone system of the Mastini patent, the local radio transmitter and receiver is intended to serve but a single telephone subscriber and it is located at that subscriber's ordinary telephone in his home or office.

The operation of Mastini's patented system may be readily understood by reference to Fig. 1 of the patent (167a) which figure has been reproduced on the foldout at the end of this brief. The subscriber's telephone 9 is normally connected to the telephone central office 5 by wire lines in the conventional manner, just as the telephone in one's home is connected. When the subscriber is at his remote radio-telephone station 1 (as in his car) and wants to make a call, he energizes the radio transmitter 17 at the remote station. The radio transmitter 17 radiates energy which is received by the local radio receiver 23 associated with his ordinary telephone 9, and, under the influence of this energy, a "remote control" system is actuated by which the local radio transmitter and receiver "is connected with the central station 5 while the *ordinary*

telephone apparatus 9 at the sub-station *is disconnected from the network, . . .*" (patent, 168a; col. 1, lines 32-37).*

In contrast with Mastini's system, the local radio transmitter and receiver in respondents' systems is located at a telephone central office where it is associated with a manually attended toll switchboard rather than an ordinary telephone. It serves a number of radio-telephone subscribers, without regard to whether or not each happens also to subscribe to ordinary wire line telephone service.

The operation of respondents' radio-telephone systems is illustrated by the diagram** which is also reproduced on the foldout at the end of this brief. When the mobile radio-telephone subscriber makes a call from his car, the signal F_2 which he transmits is picked up by the continuously-energized "radio receiver", and routed through apparatus called a "control terminal" to the "toll switchboard (mobile service pos.)". His incoming call causes a line lamp on that switchboard to light, and the light alerts the switchboard operator to the fact that a call is coming in. She manually inserts a plug in the jack in her switchboard corresponding to the calling line and answers, for example: "New York mobile operator". This signal, going out through the "control terminal" and the local radio transmitter "radio trans.", is shown reaching the car as F_1. The calling party then tells her what number he wants to reach, she manually selects and plugs into a trunk line leading to the appropriate central office (the "local swbd"), and then dials the required digits to connect him with the particular subscriber he wishes to call. This connects him to the ordinary wire line telephone shown at left, and he is able to converse with the party at that telephone.

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*Emphasis in quotations is ours throughout, unless the contrary is noted.

**This diagram (28a) is taken from the stipulation defining respondents' accused radio-telephone systems.

The foregoing descriptions of the patented and accused radio-telephone systems make apparent two fundamental differences between them:

1. In the accused systems the local radio transmitter and receiver is not associated with a subscriber's ordinary telephone; and

2. In the accused systems no subscriber's ordinary telephone is disconnected from the network when a remote radio transmitter and receiver is energized; and therefore, of course, the accused systems include no "means" for disconnecting such an ordinary telephone.

The original claims (88a-89a), submitted to the Patent Office by Mastini in the application for his patent, were not limited to these features. However, during the prosecution of his application Mastini was obliged, in order to avoid rejection of his claims, to limit each of them to the very features, described above, which distinguish the patented system from the accused radio-telephone systems. To induce the Patent Office to grant his patent, Mastini had to limit each of his claims by recitation of: 1) an ordinary "telephone sub-station" with a local radio transmitter and receiver associated with it, which telephone is normally connected by wire lines to a telephone central office, and 2) "means" by which the ordinary telephone sub-station is disconnected, and the local radio transmitter and receiver substituted in lieu of it, upon receipt of radio energy from a remote radio transmitter.

Claim 1, which is representative, is reproduced below with the limitations to these features underlined:

"1. In combination, a remote radio transmitter, a local telephone sub-station, a central station, wire lines normally interposed between said local sub-station and said central station, local radio receiving

> apparatus and means whereby radio signals received by said local receiving apparatus from said remote radio transmitter cause the disconnection of the local sub-station from the wire lines and the connection of the radio receiving apparatus thereto instead."*

By his own voluntary acts before the Patent Office, Mastini precluded himself from seeking any interpretation of his claims which would be so broad as to encompass any radio-telephone system which does not include both of these features. As both courts below held, he cannot now urge a construction of his claims which would be so broad as to include respondents' systems—which do not include either feature.

Reasons For Denying The Writ

1. The Holdings of Non-infringement Below Are Manifestly Correct

The doctrine of file wrapper estoppel has long been established by decisions of this Court. *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 443 (1926):

> "It is well settled that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent."

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*All claims of the Mastini patent, with these limitations underlined in each, are reproduced in the appendix to respondents' brief in the Court of Appeals at 169a-170a.

Graham v. *John Deere Co.*, 383 U. S. 1, 33 (1966):

> "Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent."

Here Mastini, "compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element", limited all of his claims by recitation of 1) the ordinary "telephone sub-station", and 2) "means" for its disconnection upon receipt of radio energy.

Neither element can be found in respondents' accused systems. Therefore both courts below, invoking the doctrine of file wrapper estoppel, found the Mastini patent not infringed.

Relying on statements in the patent itself (168a; col. 1, lines 10-15, 28-35) and in its file wrapper (103a, 104a), the District Court rejected Mastini's contention that respondents' toll switchboard could be considered the ordinary telephone sub-station of the patent claims (P. App. 14):

> "We read MASTINI's invention as limited to a combination which contained a single subscriber's telephone at the substation. . . . Secondly the claim language cannot be read as applied to a switchboard."

The Court of Appeals agreed (369 F. 2d at 379):

> "It is equally clear that Mastini's 'local substation' cannot include a central switchboard. In the File Wrapper the sub-station is alternatively de-

> scribed as a 'subscriber's station' and the patent itself clearly states that Mastini's invention requires alteration only at the subscribers' telephone, not at the central telephone plant. Again, as Mastini was forced to add this 'sub-station' to his claims to avoid rejection on the prior art, he is estopped to now include what he was forced to abandon to obtain his patent. *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966)."

The lack of a sub-station in respondents' systems is, by itself, sufficient basis for a holding of non-infringement. But, since respondents' systems lack the "local telephone sub-station", they also lack any remote control or automatic "means" for disconnecting this non-existent element.

This additional basis for a finding of non-infringement was also recognized by the District Court (P. App. 5, 11, 13, 14a), and by the Court of Appeals (369 F. 2d at 379):

> "Chief Judge Ryan correctly concluded that the Mastini patent was limited to automatic means. The patent itself sets out in detail the functioning of an automatic system but does not mention the possibility of manual operations. Further, the File Wrapper history illustrates that Mastini was forced to cancel his early claims because of various prior art references. To overcome these references, new claims were submitted and Mastini remarked: 'none of [these references] describes the idea of automatically switching ***.' Elsewhere Mastini distinguishes his invention from one requiring the presence of an operator."

The lower courts' findings of non-infringement, amply supported by the record and based on well-established legal doctrine, are clearly correct.

2. Petitioner's Attacks on the Judgments Are Completely Without Merit

Nearly a year after the judgments of non-infringement had been entered by the District Court, petitioner sought relief from these judgments by motions pursuant to Rule 60(b) F. R. C. P. He charged that the judgments were tainted by 1) surprise; 2) newly-discovered evidence; 3) fraud, misrepresentation and other misconduct; and 4) difficulty in communicating with his attorneys (P. App. 138-141).

The District Court denied petitioner's Rule 60(b) motions in all respects (P. App. 137).

On the appeal from this denial, petitioner restricted himself to the charges of fraud. Of these charges the District Court had said (P. App. 137):

> "The fraud charges are not attempted to be substantiated by any facts; it consists merely of reckless and libelous accusations."

The Court of Appeals agreed (369 F. 2d at 379):

> "Chief Judge Ryan found that appellant was attempting to use a Rule 60 motion to relitigate the merits of his claim and that the allegations of fraud were not substantiated . We agree."

3. No Conflict of Decisions or Question of Public Importance Is Presented

There is no decision of another court in conflict with the decisions of the courts below.

The holding of non-infringement in this case inevitably follows from routine application of the well-established doctrine of file wrapper estoppel which has been repeatedly enunciated by decisions of this Court.

This case is merely a private controversy on a question of alleged patent infringement.

Conclusion

The petition should be denied.

Respectfully submitted,

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